

### REMARKS

Claims 1-3, 5, 7 and 9-13 were pending and under consideration prior to the January 30, 2004 Office Action. Claims 2-3 and 9 were objected to and claims 10 and 11 were rejected. Claims 1, 5, 7, 12 and 13 have been allowed. Applicants thank the Examiner for the indication of allowable subject matter.

In response, claims 10 and 11 have been amended herein to more clearly point out that which Applicants regard as the invention. Specifically, claims 10 and 11 have been amended to delete the phrase "for a time sufficient to induce apoptosis in a cell exhibiting normal acid sphingomyelinase activity". No new matter has been added by the present amendments. Accordingly, after entry of the present amendment, claims 1-3, 5, 7 and 9-13 will be pending and under consideration.

#### 1. OBJECTIONS

Claims 2-3 and 9 were objected to because of alleged typographical errors. Specifically, claims 2-3 were objected to for the alleged recitation of "that f" and "apopt sis" in claim 2, line 13. Claim 9 was objected to for the alleged recitation of "morphol gy" and "zei sis" in claim 9, line 2.

Applicants respectfully submit that the alleged typographical errors were introduced by the facsimile transmission. Applicants' original document, which was faxed to the U.S. Patent and Trademark Office, recites "of step (e) (b), or the level of ceramide in the cell of step (b) (a) is greater than that of the cell in step (e) (b), the test compound represents a compound which increases a cell's sensitivity to acid sphingomyelinase-related apoptosis." in claim 2, lines 12-14<sup>1</sup>. Applicants' original document recites "morphology comprises cellular condensation, nuclear condensation or zeiosis." in claim 9, line 2.

The text of objected claims 2 and 9 is being resubmitted as part of the Listing of Claims. Applicants respectfully request that the Listing of Claims be entered into the file history of the present application. If the text of objected claims 2 and 9 continues to have transmission problems, or if any other text in the present amendment is believed by the Examiner to have

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<sup>1</sup> Applicants note that disputed words do not appear in Applicants' original claim 2, line 13.

errors, the Examiner is asked to telephone the undersigned to request that the Amendment be re-sent.

2. **THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 10 and 11 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action alleged that the recitation of "for a time sufficient to induce apoptosis in cell exhibiting normal acid sphingomyelinase" in claims 10 and 11 is ambiguous and indefinite because acid sphingomyelinase deficient cells somehow exhibit acid sphingomyelinase activity.

Without conceding to the validity of the rejection and in an effort to advance prosecution of the present application, Applicants have amended claims 10 and 11 to delete the recitation of "for a time sufficient to induce apoptosis in cell exhibiting normal acid sphingomyelinase." Thus, the rejection under 35 U.S.C. § 112, second paragraph has been rendered moot.

In view of the foregoing, Applicants respectfully request withdrawal of this rejection.

**CONCLUSION**

Applicants respectfully request entry and consideration of the foregoing amendments and remarks. An early allowance is earnestly sought. No fee is believed to be due in connection herewith. If any fee is due, however, please charge the required fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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